

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Kevin A. Gray et al.

Application Number: 10/532,944

Filed: 06/21/2006

Title: Amylases, nucleic acids encoding them and methods for making and using them

Group Art Unit: 1652

Examiner: RAGHU, GANAPATHIRAM

Confirmation Number: 2689

Request For Reconsideration Of Patent Term Adjustment
Under 37 C.F.R. § 1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir,

Further to the USPTO Notice of allowance mailed on January 7, 2010, informing the applicant that the patent term adjustment until the notice allowance of this patent application is 24 days, applicants hereby respectfully request reconsideration of the patent term adjustment (PTA) for the above mentioned patent application.

A copy of the notice of allowance has been attached.

Applicants request reconsideration of the patent term adjustment for the above noted application in light of the recent decision on January 7, 2010 from the United States District Court for the District of Columbia in Wyeth v. Kappos, case No. 2009-1120 (Judge James Robertson).

The court issued the decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect and the periods of 35 U.S.C. §154(b)(2)(A) delay "overlap" with 35 U.S.C. §154(b)(2)(B) delay only if they occur on the same day.

Applicants have recalculated PTA for the above mentioned patent under the court's interpretation of the PTA statute and have determined that the patent is entitled to 441 days PTA on the date of issue. Applicants hereby request to reconsider the total PTA at issue as 441 days.

PTO Delay A (days): 150

PTO Delay B (days): 356

Overlap (days): None

Applicant Delay (days): $58 + 7 = 65$ days

PTA Calculation: (PTO Delay A + PTO Delay B - Overlap - Applicant delay)

PTA = $(150 + 356 - 0 - 65) = 441$ days

The attached sheet provides details of the circumstances during the prosecution of the application resulting in the patent that constitutes a failure to engage in reasonable efforts to conclude processing or examination of an application.

A fee in compliance with the requirement under 37 CFR 1.705(b)(1) is attached hereto.

Respectfully Submitted

Dated: April 28, 2010

By /Jennifer Risser/
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| Document | Date | PTO Delay (A) | PTO Delay (B) | Applicant Delay | Overlap |
|---|------------|---------------------|---------------------|--------------------|---------|
| Expected issue date of the patent (28 weeks from notice of allowance) | 07-20-2010 | | | | |
| Notice of Allowance and Fees Due (PTOL-85) | 01-07-2010 | | | | |
| Amendment/Req. Reconsideration-After Non-Final Reject | 11-20-2009 | | | | |
| Applicant response Due | 09-22-2009 | | | | |
| Non-Final Rejection | 06-22-2009 | | | | |
| Request for Continued Examination (RCE) | 04-21-2009 | | 356 | | |
| Amendment/Req. Reconsideration-After Non-Final Reject | 10-29-2008 | | | 58 | |
| Applicant response Due | 09-01-2008 | | | | |
| Non-Final Rejection | 05-30-2008 | | | | |
| 3 years from Commencement of National stage | 04-30-2008 | | | | |
| Response to Election / Restriction Filed | 04-25-2008 | | | 7 | |
| Applicant response Due | 04-18-2008 | | | | |
| Requirement for Restriction/Election | 01-18-2008 | 150 | | | |
| PTO response Due | 08-21-2007 | | | | |
| Patent application Date | 06-21-2006 | | | | |
| 30 months from Priority date (Commencement of National stage) | 04-30-2005 | | | | |
| Priority date(US Provisional Application "60/423626") | 10-31-2002 | | | | |



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: 1500 M STREET, N.W. 20540
P.O. Box 1460
Alexandria, Virginia 22304-1460
www.uspto.gov

NOTICE OF ALLOWANCE AND FEE(S) DUE

APP/17 7000 02/07/2010
VERINUM CORPORATION
Intellectual Property Department
P.O. Box 910550
SAN DIEGO, CA 92191-0550

| | |
|------------------------------|----------------|
| EXAMINER | |
| WACHS, GABRIEL HENRY | |
| ART UNIT | 2566/0136/0000 |
| CLASS | |
| DATE: MAR 03 01:07:00 PM '10 | |

| APPLICATION NO. | FEES PAID TO | INVENTOR(S) | ATTORNEY/AGENT'S NO. | CONFIRMATION NO. |
|-----------------|--------------|---------------|----------------------|------------------|
| 09/532,264 | 09/13/09 | Kevin A. Gray | 10530-0N | 2889 |

TITLE OF INVENTION: AMYLASE, NUCLEIC ACIDS ENCODING THEM AND METHODS FOR MAKING AND USING THEM

| APPL. TYPE | SMALL ENTITY | ISSUE FEE DUE | PUBLICATION FEE DUE | ENTRY FEE/ISSUE FEE | TOTAL FEE(S) DUE | DATE DUE |
|----------------|--------------|---------------|---------------------|---------------------|------------------|------------|
| nonprovisional | YES | \$755 | \$390 | 00 | \$1145 | 04/07/2010 |

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fees to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: 18-month patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), in: **Mail** **Mail Stop ISSUE FEE**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
or **Fax** (571)-273-2885

INSTRUMENTS. This form should be used for transmitting the **ISSUE FEE** and **PUBLICATION FEE**, if required; Blocks 1 through 5 should be completed when appropriate. All factors concerning: including the Patent, Advance orders and notification of maintenance fees will be mailed to the current correspondence address at indicated unless corrected notice or change otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "SEE ABOVE" for maintenance fee notification.

(SEE BLOCK 1 FOR CORRESPONDENCE ADDRESS) ADDRESS Change, Use Block 1 for change of address

23631 7890 015/07/05

VERNEHM CORPORATION
Intellectual Property Department
P.O. Box 910550
SAN DIEGO, CA 92191-0550

Note: A certificate of mailing can only be used for domestic mailings of the (Fee(s)) Transmittal. This certificate cannot be used for any other correspondence address at indicated unless corrected notice or change otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "SEE ABOVE" for maintenance fee notification.

Certificate of Mailing or Transmittal

I hereby certify that this (fee(s)) transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE; address above, or being the transmittal transmitted to the USPTO (571) 273-2885, on the date indicated below:

| |
|--------------------|
| Transmitter's name |
| Signature |
| Date |

| APPLICATION NO. | PUBLICATION DATE | INVENTOR NAME(S) | ATTORNEY/AGENT NO. | CORRESPONDENCE NO. |
|-----------------|------------------|------------------|--------------------|--------------------|
| 09/31/04 | 09/21/2006 | Kevin A. Gray | DIS-00-00 | 2669 |

TITLE OF INVENTION: AMYLANES, NUCLEIC ACIDS ENCODING THEM AND METHODS FOR MAKING AND USING THEM

| APPL. NO. TYPE | SMALL ENTITY | ISSUE FEE (U.S.) | PUBLICATION FEE (U.S.) | ENTRY FEE (U.S.) | ENTRY FEE (U.S.) | TOTAL FEE (U.S.) | DATE (U.S.) |
|----------------|--------------|------------------|------------------------|------------------|------------------|------------------|-------------|
| 09/31/04 | YES | \$755 | \$300 | NO | \$0.00 | \$1055 | 04/07/2010 |

| EXAMINER | ATTORNEY | CLASSIFICATION |
|---------------------|----------|----------------|
| RAJIB, CANADATHIRAM | 1652 | 435-1800-0 |

1. Change of correspondence address or indication of "Free Address" (37 CFR 1.301)

- ☐ Change of correspondence address for Change of Correspondence Address form PTO 0514 (12) attached
- ☐ Free Address indication on Free Address Indication form (PUB. 0514) or more recent attached. Use of a Customer Number is required.

2. For printing on the present front page, list

- (1) the names of up to 3 registered patent attorneys or agents (OR, alternatively),
- (2) the name of a single firm (that is a registered or registered attorney or agent) and the names of up to 3 registered patent attorneys or agents. If no name is listed, no name will be printed.

3. ASSIGNEE NAME AND RESIDENTIAL DATA TO BE PRINTED ON THE PATENT (form or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee can be printed on the patent. If an assignee is identified below, the document has been filed for recordation or is on file in 37 CFR 1.311. Completion of this form is NOT a substitute for filing an assignment.

(a) NAME OF ASSIGNEE: _____

(b) RESIDENCE (CITY AND STATE OR COUNTRY): _____

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

- ☐ Issue fee
- ☐ Publication Fee (No small entity discount permitted)
- ☐ Advance Order - # of Copies: _____

4b. Payment of Fee(s) (Please first receipt any previously paid fees for shown above):

- ☐ A check is enclosed.
- ☐ Payment by credit card (Form PTO-2036 is attached)
- ☐ The Director is hereby authorized to charge the required fee(s), any deficiency or credit any overpayment to Deposit Account Number: _____ (Indicate an entry copy of this form)

5. Change in Entity Status (from status indicated above):

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27
- ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant, a registered attorney or agent, or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature: _____ Date: _____

Typed or printed name: _____ Registration No.: _____

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit for the public which is not fully (and by the USPTO is provided) as required. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is required to take 37 months to complete including gathering, preparing, and examining the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time or length to complete this form and/or suggestion for action to be taken should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. (43) 0001 SEND FEES OR COMPLETED FORMS TO THIS ADDRESS, SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450

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| APPL. NO. / FILING NO. | FILED DATE | PATENT NUMBER / INVENTOR | ATTORNEY / AGENT | EXAMINER / REVIEWER |
|------------------------|------------|--------------------------|------------------|---------------------|
| 10572-944 | 09/21/2006 | Kern, A. Qing | DI'CHO'AN | 2649 |

ADVIS: 7/1/06 10/19/2009

VERENIUM CORPORATION
Intellectual Property Department
P.O. Box 910550
SAN DIEGO, CA 92191-0550

EXAMINER

SACRED: EXAMINATION

ART UNIT: 2649

1/22
DATE MAILED: 11/17/2010

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 24 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 24 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.